

Remarks

Claims 1-19 are currently pending, and claims 18-19 have been amended only to address a section 112 rejection, while claim 20 has been cancelled. Applicants assert that the claims are in condition for allowance after final as set forth more fully below. Because at least some claims are allowable over the current rejections without there being any amendments requiring further searching and consideration, Applicants further assert that either the finality of the current rejection of these claims be withdrawn or an indication of allowable subject matter for these claims be provided.

Objections to the Drawings

The Examiner has objected to the drawings for failing to show an extension pole, as recited in claim 20. Claim 20 has been cancelled. Therefore, it is respectfully requested that the objection to the drawings be withdrawn.

112 Rejections

Claims 18 and 19 have been rejected under 35 USC 112 as being indefinite due to a combination/sub-combination issue relative to language about a barrel. The Office Action states that the “support device” is said to be “connected to the barrel” in claim 19, but this is not a correct reading of claim 19. Claim 19 recites that a muzzle extender is connected to the barrel, not the support device. Claims 18 and 19 have been amended to more clearly indicate that the piston, barrel, and muzzle extender are sub-elements of the powder driven tool that are separate from the support device itself but that cooperate with the support device. The overall assembly includes the powder driven tool element and the support device element in cooperation with the powder driven tool. Accordingly, Applicants assert that there is no combination/sub-combination issue and request that the 112 rejections be withdrawn.

103 Rejections

Claims 1-17

Claims 1-6, 8, and 10-17 are rejected under 35 USC 103(a) as being unpatentable over Sprague (US 2004/0064932). Applicants respectfully traverse these rejections.

As previously argued by the Applicants in relation to independent claims 1 and 16 and as conceded by the Examiner, Sprague does not disclose a pusher and support member that are integral to the shaft. Instead, the portion 5 (referred to as a pusher) is separately attached to the portion 20 (referred to as a shaft) while the portion 24/10 (referred to as a support member) is integral with the portion 20. However, the Office Action now states that it would be obvious to modify Sprague to make the portion 5 integral with the portion 20 to thereby render the claims unpatentable. In making this obviousness rejection, the Office Action has ignored or otherwise left unaddressed the arguments made in the previous response as to why there is no motivation to modify Sprague in this way.

It is black letter law that there must be motivation to combine references or otherwise modify a reference in the context of a 103(a) rejection. It is also black letter law that there can be no motivation for such modification when the reference teaches away from such a combination, i.e. the modification renders the prior art unsatisfactory for its intended purpose. There can also be no motivation when the principle of operation of the primary reference would be changed by the modification. Such reasoning for no motivation is set forth at MPEP 2143.01.

In the present case, Sprague teaches away from the modification of making portion 5 integral with portion 20. Sprague emphasizes the importance of the portion 5 being able to be attached to and removed from the portion 20 so that the portion 5 can be repeatedly used to install multiple steps 100 in a structure. Furthermore, being able to remove portion 5 from portion 20 allows a user to step onto portion 20, which is the whole purpose of installing the portion 20 into the pole as disclosed in Sprague. Leaving portion 5 attached to portion 20, which would be the case if portion 5 and portion 20 were made integral, would prevent portion 5 from being re-used for multiple portions 20 and would hinder a user from stepping into the step formed by portion 20 once installed in the pole.

Therefore, Sprague teaches away from portion 5 and portion 20 being integral because portion 5 is to be re-used and because the user is said to be able to step into the portion 20. Furthermore, Sprague's principle of operation would be altered upon such a modification because portion 5 could no longer be re-used and because the user would be

hindered and would no longer be able to simply step into the portion 20 once it is installed in a pole. Thus, there can be no motivation to modify Sprague to make portion 5 and portion 20 be integral such that the 103(a) rejection based on Sprague fails. Therefore, because claims 1-17 are rejected at least on the basis of such a modification to Sprague, all claims 1-17 are allowable.

Dependent claims

Dependent claims 2-15 and 17-19 depend from allowable base claims and are also allowable for at least the same reasons. Furthermore, one or more of claims 2-15 and 17 recite additional features that are allowable over Sprague. The Office Action appears to overlook the subject matter of several of these claims as no discussion of how Sprague discloses the claim elements has been provided.

As one example, claim 5 recites that there is a stop member distally of the threads on the shaft. There is no discussion whatsoever of these recitations in the rejection based on Sprague, and Applicants assert that Sprague fails to disclose such a stop member. There is no stop at the base of the threads in Sprague.

As another example, claim 8 recites that there are a plurality of rigid support members. There is no discussion whatsoever of these recitations in the rejection based on Sprague, and Applicants assert that Sprague fails to disclose a plurality of rigid support members. Sprague only discloses the one foot hold that the Office Action has equated to a support member and provides no reasoning as to why one step intended for one foot could be modified to provide multiple foot holds.

As yet another example, claim 12 recites that the pusher is tapered. There is no specific citation to where Sprague discloses a tapered pusher. Instead, the portion 5 has no taper but is instead a cylindrical object where the opposing sides remain the same distance apart throughout its length such that there is no taper whatsoever.

Claims 7 and 9 have been rejected based on Sprague in view of Malmgren. The Office Action states that Malmgren discloses a ring portion. However, as previously argued, Malmgren discloses a cork-screw portion 6 that does NOT close on itself as a ring does, and something attached to portion 6 could become free by sliding to the end opposite the threads 9. In fact, Malmgren discloses portion 6 only as being a safety

foothold rather than something to secure an object. The Office Action is impermissibly construing “ring” to mean “corkscrew” rather than something that closes on itself, and therefore these rejections based on Malmgren fail.

Claims 18-19

Claim 18 recites in part a powder driven tool including a powder cartridge, barrel, piston, and a trigger for actuating the piston within the barrel and a support device including a pusher on a first end where the pusher is located at least partially within the barrel and is adapted to receive force applied from the piston for driving a second end of the support device into a pole. The Examiner has combined a new reference, Chun (US Pat 5,135,150) with Sprague and Malmgren to reject claims 18-20. However, Chun specifically states that the powder driven tool lacks a trigger and piston rod, col. 2, lines 3-7. Thus, this combination of references fails to disclose all of the elements of claims 18 and 19 since the powder driven tool of Chun does not include the trigger and piston as recited in these claims. Therefore, this final rejection must be withdrawn as well.

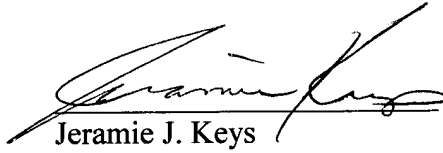
Conclusion

Applicants assert that the application is now in condition for allowance after final. Applicants request reconsideration in view of the amendments and remarks above and further request that the finality of the rejections be withdrawn or an indication of allowable subject matter be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: April 13, 2005



Jeramie J. Keys
Reg. No. 42,724

Withers & Keys, LLC
P.O. Box 71355
Marietta, Ga 30007-1355
(404) 849.2093